

## REMARKS

The rejection of claims 12, 13, and 15 under 35 U.S.C. 112 second paragraph has been addressed by amending these claims as suggested by the examiner and, therefore, it is believed that these rejections are obviated.

The examiner has rejected claims 1 and 3-15 (all of the claims pending in the application) as being unpatentable under 35 U.S.C. 103(a) over applicants' admitted prior art, hereafter AAPA, in view of Japanese Patent 2000-68620, hereinafter 620, and Gerber et al, U.S. Patent 5,401,913, hereinafter Gerber et al. This rejection is not thought to be well taken.

First, claim 1, upon which all of the other claims depend, directly or indirectly, requires a voltage plane as a sheet of foil disposed on a dielectric, and laminating the voltage plane to the signal plane with a sticker sheet therebetween. It is respectfully submitted that none of the prior art suggests this. With respect to Gerber et al, no voltage plane is shown, and the films of material 58, 24, 60 and 62 may be an anisotropically conductive adhesive (Col. 6, lines 36-39). And, since there is no voltage plane shown in the prior art, it cannot be oriented toward the signal plane. Thus, the references do not show or teach the invention as claimed.

Moreover, at the locations cited by the examiner of the 620 patent, namely paragraphs [0011], [0012] and [0065], it appears that the roughening of the lands is to obtain better connection of the lands to other conductive material.

“[0011] According to the 1<sup>st</sup> above-mentioned configuration, since the contact interface with the conductive constituent of a circuit pattern is roughened, a touch area increases and the dependability of connection improves according to the operation which the number of points of contact of the conductive filler in a conductive constituent and the metallic foil of a circuit pattern increases, or heightens adhesive strength of the resin and the circuit pattern which are contained in a conductive constituent.”

Since the translation furnished by the PTO was done by a machine, it is difficult to understand it completely. However, it is clear that in applicants' case, the roughening is for adhesion to a dielectric material, i.e. the sticker sheet, not a conductive material.

The reasons for smooth and roughened surfaces is explained in detail on page 1, line 13 - page 2, line 13, of the instant application. None of these reasons apply to the art cited by the examiner and, thus, there cannot be any motivation to combine the references.

It is not enough that one may modify a reference in view of a second reference, but rather it is required that the second reference suggest modification of the first reference and not merely provide the capability of modifying the first reference.

The CAFC stated in In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

“The Supreme Court in Graham v. John Deere Co., 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the ‘burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103’. Citing In re Warner, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967).”

The law is quite clear that in order for a claimed invention to be rejected on obviousness, the prior art must suggest the modifications sought to be patented; In re Gordon, 221 U.S.P.Q. 1125, 1127 (CAFC 1984); ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (CAFC 1984). The foregoing principle of law has been followed in Aqua-Aerobic Systems, Inc. v. Richards of Rockford, Inc., 1 U.S.P.Q. 2d, 1945 (D.C. Illinois 1986). In the Aqua-Aerobic's case, the Court stated that the fact that a prior reference can be modified to show the claimed invention does not make the modification obvious unless the prior reference suggests the desirability of the modification. The CAFC in the case of In re Gorman, 18 U.S.P.Q. 2d (CAFC 1991) held at page 1888:

"When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant [citation]. 'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination' [citations]. . .

The references themselves must provide some teaching whereby the applicant's combination would have been obvious."

Further, the CAFC, in In re Oetiker, 24 U.S.P.Q. 2nd 1443, 1445 (CAFC 1992) held:

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself."

Most significantly, the CAFC in the case of In re Dembiczak, 50 U.S.P.Q.2<sup>nd</sup> 1614

(CAFC 1999) held at 1617:

"...(examiner can satisfy burden of obviousness in light of combination 'only by showing some objective teaching [leading to the combination]')"

Thus, it is clear that where an individual reference does not teach the entire invention, then the modification which the invention represents must be suggested and motivated by some other reference through some objective teaching and cannot come from the application itself, which is not the case here.

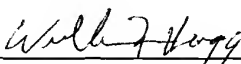
Claims 3-15 are dependent, directly or indirectly on claim 1 and, for the same reasons, are believed to be allowable. Moreover, with respect to claims 3-5, there is nothing in the prior art to suggest any degree of roughness or smoothness of the signal plane, and there is no suggestion anywhere that these choices are desirable, or even appropriate. Thus, for this additional reason, claims 3-5 are believed to be allowable.

With respect to claims 8, 9, and 13-15, since there is no suggestion of a voltage plane, there is definitely no suggestion of areas of roughness and smoothness and certainly not of that claimed in claim 9.

For all the above reasons, it is believed that each of the claims now in the application is distinguishable one from the other and over the prior art. Therefore, reconsideration and allowance of the claims are respectfully requested.

Respectfully submitted,

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